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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/132,327 | 08/11/1998 | MICHEL SAFARS | USB97-SVN-OM | 9217 |

466 7590 09/11/2002

YOUNG & THOMPSON
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ARLINGTON, VA 22202

EXAMINER

PAULA, CESAR B

| ART UNIT | PAPER NUMBER |
|----------|--------------|
| 2176 | |

DATE MAILED: 09/11/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | |
|------------------------------|-----------------|---------------|
| Office Action Summary | Application No. | Applicant(s) |
| | 09/132,327 | SAFARS ET AL. |
| Examiner | Art Unit | |
| CESAR B PAULA | 2176 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on 24 June 2002.

2a) This action is **FINAL**. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 61-74 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) Claim(s) _____ is/are allowed.

6) Claim(s) 61-74 is/are rejected.

7) Claim(s) _____ is/are objected to.

8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) The proposed drawing correction filed on _____ is: a) approved b) disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12) The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some * c) None of:

1. Certified copies of the priority documents have been received.

2. Certified copies of the priority documents have been received in Application No. _____.

3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) The translation of the foreign language provisional application has been received.

15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) Notice of References Cited (PTO-892)

2) Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.

4) Interview Summary (PTO-413) Paper No(s) _____.

5) Notice of Informal Patent Application (PTO-152)

6) Other: _____.

DETAILED ACTION

1. This action is responsive to the amendment filed on 6/24/02.

This action is made Non-Final.

2. In the amendment, claims 61-74 are pending in the case. Claim 61 is an independent claim.

3. The rejection of claim 61 under 35 U.S.C. 103(a) as being unpatentable over Small et al, hereinafter Small (Pat.# 5,898,434, 4/27/99, filed on 8/22/94), in view of Kessenich et al., hereinafter Kessenich (Pat. # 6,034,680, 3/7/2000, filed on 4/30/1997) is withdrawn as necessitated by the newly found prior art.

4. The rejection of claims 62-74 under 35 U.S.C. 103(a) as being unpatentable over Small et al, hereinafter Small, in view of Kessenich, further in view of Weinberg et al, hereinafter Weinberg (Pat.# 5,924,108, 6/13/99, filed on 3/29/96), and further in view of Fein et al, hereinafter Fein (Pat. # 5,924,108, 7/13/99, filed on 3/29/96) is withdrawn as necessitated by the newly found prior art.

Priority

5. Acknowledgment is made of applicant's claim for foreign priority under 35 U.S.C. 119(a)-(d), and based on application # PCT/FR98/00917 filed in France on 5/6/1998, which papers have been placed of record in the file.

Drawings

6. This application has been filed with informal drawings which are acceptable for examination purposes only. Formal drawings will be required when the application is allowed.

Specification

7. Appropriate corrections have been made to the abstract, therefore its objection has been withdrawn

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claim 61 is rejected under 35 U.S.C. 103(a) as being unpatentable over Small et al, hereinafter Shwarts et al, hereinafter Shwarts (Pat.# 5,524,201, 6/4/96), in view of Kessenich et al., hereinafter Kessenich (Pat. # 6,034,680, 3/7/2000, filed on 4/30/1997).

Regarding independent claim 61, Shwarts teaches the navigation, and conversion of documents into electronic books (col. 1, lines 52-col.2, line 67, and col.11, lines 4-67). Small fails to explicitly disclose *organizing a multiplicity of electronic documents using a book metaphor so that the documents are arranged as pages in chapters*. Kessenich discloses a method for displaying and organizing books into categories and placing a central address or universal location for the accessing of these books in a library format (col.2, lines 60-67, col. 3,

lines 1-12, and col. 8, lines 14-67). It would have been obvious to one of ordinary skill in the art to have combined the teachings of Shwarts, and Kessenich, because Kessenich teaches above the combination of multiple books in a carefully constructed educational context.

Moreover, Shwarts teaches the conversion of documents into electronic books. The pages being scripts or computer program, which perform different functions which access a structure of the document, such as moving to other locations, displaying dialog boxes, etc (col. 1, lines 52-col.2, line 67, and col.11, lines 4-67). Shwarts fails to explicitly disclose *providing in the electronic library an electronic catalog or copying selected ones of the pagelets*. It would have been obvious to one of ordinary skill in the art to have included a catalog, because Shwarts teaches above, the inclusion or interactive reference material in books.

10. Claims 62-74 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shwarts, in view of Kessenich, further in view of Weinberg et al, hereinafter Weinberg (Pat.# 5,924,108, 6/13/99, filed on 3/29/96), and further in view of Fein et al, hereinafter Fein (Pat. # 5,924,108, 7/13/99, filed on 3/29/96).

Regarding claim 62, which depends on claim 61, Small teaches the indexing and reorganization of document notes (col. 14, lines 28-51), the search and gathering of data (col. 13, lines 1-36), providing navigation information (col.15, lines 35-67), and the updating of data (col. 27, lines 10-37). Small fails to explicitly disclose *searching the internet and adding the search results as new pages, preparing summaries of one or more of the pages, performing statistical analyses, inserting new pages, automatically updating the electronic books*. Weinberg teaches the search, adding, performing statistical analyses, and updating of web pages to a web site (abstract, col.24, lines 47-67, col. 26, lines 32-67). Fein teaches the summarizing function for

creating the summary of a document (col. 4, lines 29-67). It would have been obvious to one of ordinary skill in the art at the time of the invention to have combine the teachings of Small, Weinberg, and Fein, because Weinberg teaches above the facilitation of web site management, and Fein discloses the automatic creation of summaries (col. 2, lines 42-46).

Claims 63-74 are directed towards a method for implementing the method found in claim 62, and are therefore similarly rejected.

Response to Arguments

11. Applicant's arguments with respect to claims 61-74 have been considered but are moot in view of the new ground(s) of rejection. The Applicant remarks that neither Small, nor Kessenich et al teach or suggest organizing electronic documents in electronic books (p.3,L.2-8). The Applicant is referred to the rejection of the claims in view of the newly found prior art as outlined above.

Moreover, the Applicant remarks that neither Small, nor Kessenich et al teach or suggest that the documents originate from various sources (p.3,L.21-25). The Applicant is referred to the rejection of the claims in view of the newly found prior art as outlined above.

Moreover, the Applicant submits that neither Small, nor Kessenich et al teach or suggest providing a catalog of pages (p.4,L.9-25). The Applicant is referred to the rejection of the claims in view of the newly found prior art as outlined above.

Moreover, the Applicant submits that neither Small, nor Kessenich et al teach or suggest that the pagelets are to be copied from the catalog to the electronic book (p.5,L.1-7). The Applicant is referred to the rejection of the claims in view of the newly found prior art as outlined above.

Conclusion

I. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cesar B. Paula whose telephone number is (703) 306-5543. The examiner can normally be reached on Monday through Friday from 8:00 a.m. to 4:00 p.m. (EST).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather Herndon, can be reached on (703) 308-5186. However, in such a case, please allow at least one business day.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-3900.

Any response to this Action should be mailed to:

Director United States Patent and Trademark Office
Washington, D.C. 20231

Or faxed to:

- **(703) 746-7238**, (for **After Final** communications intended for entry)
- **(703) 746-7239**, (for **Formal** communications intended for entry, except formal After Final communications)

Or:

- **(703) 746-7240**, (for **Informal or Draft** communications for discussion only, please label “**PROPOSED**” or “**DRAFT**”).

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA, Sixth Floor (Receptionist).

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CBP

9/5/02



STEPHEN S. WONG
PRIMARY EXAMINER